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09/970,789	10/05/2001	Lynn Ann Casey	005222.00135	1077

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EXAMINER

PLUCINSKI, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

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05/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/970,789	Applicant(s) CASEY ET AL.	
	Examiner JAMISUE A. PLUCINSKI	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-37,42-51 and 56-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10,38-41 and 52-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/15/05 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 11-37 and 42-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClelland (6,707,879) in view of Moore (6,246,778).

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5. With respect to Claims 11, 12, 22, 31, 35, 38 and 39: McClelland discloses method, a computer or a portable device (312, Column 11 line 52 to Column 12, line 11) comprising:

- a. A display screen (Reference numeral 312);
- b. A processing unit (Reference numeral 300);
- c. Memory storing a database (see abstract), McClelland discloses the use of the database storing and item file, and every item indicative of the item being scanned, McClelland does not disclose the specifics of the type of information being in the database, i.e. priority level, arrival date, importer name, risk level and commodity name, however the specific type of information within the database is considered to be non-functional descriptive material which is not functionally involved in the steps recited and is related to the intended use of the database. The receiving, displaying, and transmitting steps would be performed the same regardless of what type of information is in the database. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
- d. Memory for storing computer readable instructions that, when executed by the processor, cause the portable device to perform the steps of:
 - i. Receiving a client computer task list, by the computer or portable device from a server computer (Column 12, lines 1-11), wherein each task comprises information known about the goods prior to the shipment being inspected (Column 10, lines 31-52, the file that is created is from an x-ray machine,

therefore information is known about the item before the shipment is being inspected by a user);

ii. Displaying a task summary list on the display screen (queue, Column 10, lines 31-52) McClelland, however fails to disclose the list comprising an importer name, a risk level, and a commodity name for each task. However, the specific type of information on the task list is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The displaying steps and inspecting steps would be performed the same regardless of what type of information is in the task summary. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify McClelland to obtain the invention in Claim 35.

iii. Displaying task information on the task screen wherein the task information comprises a digital image (See Figure 4B).

iv. Receiving inspection results from a user corresponding to one of the shipments of goods (See Figures 7B-D).

6. McClelland discloses receiving inspection results however discloses the inspection is remote and not an on-site inspection. First it should be noted that a user station is connected to each machine, therefore can be considered onsite. McClelland discloses receiving inspection results from a user and fails to specifically disclose the inspection results are from an onsite

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inspection. However, the specific type of results, whether they are corresponding to an onsite inspection or a remote inspection is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The steps of transmitting and sending communications steps would be performed the same regardless of what type of inspection results they correlated to. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

7. McClelland discloses the use of sending and transmitting information, however fails to disclose the use of wireless communication. Moore discloses the use of field reader (figure 6), which is used at the border crossing and communicates using wireless communications (a product verification system that can be done at a border crossing, where at the verification side is a computer device, which communicates with the central system using wireless communications (See Column 24, lines 30-65, Column 26, lines 29-45). It would have been obvious to one having ordinary skill in the art to modify McClelland, to have the client computer be the field reader of Moore, in order to reduce the shipping of authentic goods to unauthorized points of final destination and to reduce the amount of contraband shipment (See Moore, Column 7).

8. With respect to Claims 13 and 32: McClelland discloses the task list is received during one or more wired synchronization procedures (Column 6, lines 1-23) through a second computer and a wireless communication. (See Moore, Column 25, lines 53-58)

9. With respect to Claims 14 and 23: McClelland discloses each task corresponds to a shipment of goods that is to be inspected (Column 10, lines 31-52).

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10. With respect to Claims 15 and 24: Moore, discloses the field computer is equipped with a camera (reference numeral 94), which photographs the goods, then stores the image in memory and associates the image with identifying information on the goods (See Column 24, lines 36-54)

11. With respect to Claims 16 and 25: McClelland discloses the computer readable instructions further cause the device to send a communication to a device associated with an X-ray team based on inspection information (McClelland discloses the communication that is sent to the X-ray team, causes the items to be x-rayed, therefore the examiner considers the communication to be requesting an x-ray, Column 4, lines 37-48). Furthermore, it should be noted that the type of information that the communication is comprised of, is considered to be non-functional descriptive material. The information contained in the communication does not effect any further steps of the claims, all steps would be performed the same regardless of what the communication is comprised of.

12. With respect to Claims 17, 18, 26 and 27: McClelland discloses the computer readable instructions further cause the device to send a communication to one of a device associated with an import specialist and a customs inspector, based on inspection information (Column 11, lines 1-33, McClelland discloses sending the results to customs, which the examiner considers to be an import specialist and where the communication comprises the inspection results).

13. With respect to Claims 19 and 28: McClelland discloses the computer readable instructions further cause the computer/device to perform the steps of:

- e. Displaying a research tool in response to user input (Column 7, lines 13-27).
- f. Receiving research criteria input by the user, querying the search tool and displaying results (Column 11, lines 34-50);

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14. With respect to Claim 20: McClelland and Moore, disclose the use of research tools, however fails to disclose the research tools displays news articles. It would have been an obvious matter of design choice to a person of ordinary skill in the art at the time the invention was made, to make the research tool, be a display of news articles, because Applicant has not disclosed that displaying news articles provides an advantage or is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the research tools taught by McClelland, due to the fact that they both provide secondary information to the user in order to inspect goods. Therefore, it would have been an obvious matter of design choice to modify McClelland, to obtain the invention in Claim 20.

15. With respect to Claims 21 and 29: McClelland discloses the research tool comprises an inspection look up function (Column 6, line 63 to Column 7, line 12).

16. With respect to Claim 30: McClelland discloses the research tool displays reports of trends of imported goods (Column 6, line 63 to Column 7 line 12).

17. With respect to Claim 33: McClelland discloses the use of a task list, however fails to disclose the list comprising an importer name, a risk level, and a commodity name for each task. However, the specific type of information on the task list is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The displaying steps and inspecting steps would be performed the same regardless of what type of information is in the task summary. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore it

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would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify McClelland to obtain the invention in Claim 33.

18. With respect to Claim 34: Moore discloses the use of wireless communications Column 26, lines 29-45.

19. With respect to Claim 36: McClelland discloses the use of analysis reports displayed on the screen (See Figure 3, Reports)

20. With respect to Claim 37: McClelland discloses the computer readable instruction further cause the computer to perform the steps of:

g. Displaying an inspection look up box on the display screen, wherein the user enters a selected date, a list of inspections corresponding to that date is displayed on the screen (See Figures 4A, B and 9).

21. With respect to Claims 42 and 43: McClelland discloses the use of a method of clearing a shipment of goods into a country (McClelland discloses the system can also be used for shipment of goods, Column 4, lines 17-24), comprising the steps:

h. Receiving a client computer task list from a server computer and displaying the list on the computer (queue, Column 10, lines 31-52, the file that is created is from an x-ray machine, therefore information is known about the item before the shipment is being inspected by a user);

i. Receiving user input selecting a first task from the task list and displaying detailed information corresponding to the task (see Figure 4B with corresponding detailed description)

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- j. Inputting inspection results into the client computer (Column 3, lines 1-17)
- McClelland discloses (column 5, lines 35-67) an embodiment where information from the baggage machines and the server are connected through a bridge, and disclose that the operator of the bridge is located on the premises of the local network of baggage scanning machines, Therefore this embodiment of McClelland, even though calling it a “remote” screening, the operator that has access to the data on the server (considered to be the user) is located on the premises of the baggage scanning machine, hence “at a location of goods being inspected”, the location being the same airport;
- k. Sending the inspection results from the client computer to the server computer (Column 4, lines 1-5, Column 5, lines 9-16).
22. McClelland discloses the use of sending and transmitting information, however fails to disclose the use of a handheld computer using wireless communication. Moore discloses the use of field reader (figure 6), which is used at the border crossing and communicates using wireless communications (a product verification system that can be done at a border crossing, where at the verification side is a computer device, which communicates with the central system using wireless communications (See Column 24, lines 30-65, Column 26, lines 29-45). It would have been obvious to one having ordinary skill in the art to modify McClelland, to have the client computer be the field reader of Moore, in order to reduce the shipping of authentic goods to unauthorized points of final destination and to reduce the amount of contraband shipment (See Moore, Column 7).
23. With respect to Claim 44: See McClelland Figure 4B with corresponding detailed description.

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24. With respect to Claim 45: Moore, discloses the field computer is equipped with a camera (reference numeral 94), which photographs the goods, then stores the image in memory and associates the image with identifying information on the goods (See Column 24, lines 36-54)

25. With respect to Claim 46: McClelland discloses sending a communication to a device associated with an X-ray team based on inspection information (Column 4, lines 37-48).

26. With respect to Claims 47 and 48: McClelland discloses the step of sending a communication to one of a device associated with a customs inspector, which the examiner also considers to be an import specialist (Column 11, lines 1-33).

27. With respect to Claim 49: McClelland further discloses the steps of accessing a research tool from the client computer and performing research corresponding to the shipment of goods (Column 7, lines 13-27).

28. With respect to Claim 50: McClelland further discloses the research tool comprises reports of trends of imported goods (Column 6, line 63 to Column 7 line 12).

29. With respect to Claim 51: McClelland discloses the research tool comprises an inspection look up function (Column 6, line 63 to Column 7, line 12).

30. With respect to Claims 56-58: McClelland discloses information which is known prior to inspection, however fails to disclose the information being known prior to the shipment being shipped. However, the information being known prior to the shipment being inspection, being known prior to the shipment being shipped is considered to be non-functional descriptive material, and does not functionally affect any of the claimed steps. The claims are drawn to a method of inspection, not a method of shipping, and whether the information is known prior to shipping the items, as opposed to prior to inspection, does not functionally affect any of the steps

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outlined in the claims. When the information is known, whether it be prior to shipping, or prior to inspection does not affect any of the steps claimed. All claimed inspection steps would be performed the same regardless of how far in the past the information was known. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Response to Arguments

31. Applicant's arguments filed 11/3/06 have been fully considered but they are not persuasive.

32. With respect to the argument of claim 31, the data within the data structure being non-functional: The applicant has stated that the examiner's logic is not correct, and states that data structures are in fact patentable. Data structures are patentable if embodied on a medium, however the information within the data structures are given patentable weight only if the data becomes functional, if further steps in the claim use the specific data, or if they manipulate the specific type of data. However, if the subsequent steps in the claims would be performed the same, regardless of what type if data is being stored, then the data itself is considered to be non-functional descriptive. For example, if the data structure stores tasks list data comprising time and date of inspection, and the claim goes on to simply state that the stored task list data is displayed (and not used by the user), then what type of data that is stored is non-functional descriptive, cause no matter what type of data is stored the displaying step would be the same. IF the claim goes on to state to display task list data for a specific time and date of inspection,

then the time and date would then become functional. Therefore because the further steps of the claims would be performed the same regardless of what specific data is used, or what data is being stored on the database, the database it self is functional however the type of data becomes non-functional. The differences in the prior art and the claimed invention were not ignored, they were addressed in the claims, however unless the specific data is utilized in any way, the type of data itself is considered to be non-functional descriptive.

33. With respect to Applicants argument of the claim limitation of “wherein each task comprises information known about a unique shipment of goods prior to the shipment being inspected”: As pointed out in the rejection above, the examiner considers McClelland to disclose this information in Column 10, lines 31-52. The file of McClelland, which is in a queue which the examiner considers to be the task list is created is from an first x-ray machine, therefore information is known about the item before the shipment is being inspected by a user. The applicant has argued that the x-ray is an inspection process, therefore information is now known about the item prior to inspection. However, there are multiple points at which the item is inspected. And the "inspection" of McClelland is considered to be the physical inspection by the user. So before the item is physically inspected by the user, the item is scanned by an x-ray, a file is created and put in queue, and then used for the physical inspection. Therefore information is known prior to the physical inspection.

34. With respect to Applicant’s argument that that there is no motivation to combine McClelland with Moore: The applicant is arguing that there is no motivation to combine based on the fact that McClelland teaches away from using a device at the site of inspection, and teaches spatial separation between the location of the goods and the location of the human

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inspector. As stated above, McClelland does in fact teach in Column 5, an embodiment where the operator of the “remote” bridge is on the same premises as the baggage inspection machines. Therefore, it is the examiner’s opinion, where as McClelland enables “remote” inspection, it does not teach away from Moore, where there would be an in-person inspection process. Furthermore, KSR states that “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. KSR [127 S Ct. at 1739]. Both the methods of onsite and offsite inspections are known, therefore it would be obvious to substitute one for the other.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/
Primary Examiner, Art Unit 3629